



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/666,862 | 09/21/2000 | Akiko Horiguchi | H&A-100-03 | 5908 |

24956 7590 04/05/2004

MATTINGLY, STANGER & MALUR, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

NGUYEN, NAM V

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2035

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,862

Applicant(s)

HORIGUCHI ET AL.

Examiner

Nam V Nguyen

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/21/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2635

DETAILED ACTION

The application of Horiguchi et al. for a "service system, information processing system and interrogator" filed September 21, 2000 has been examined.

This application claims foreign priority based on the application 2000-180044 filed June 15, 2000 in Japan. Receipt is acknowledged of papers submitted under 35 U.S.C 119(a) – (d), which papers have been placed of record in the file.

This application is a CIP of 09/645,401 filed August 25, 2000.

A preliminary amendment to the specification has been entered and made of record.

Claims 1-11 are pending.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The current abstract using phrase "the present invention" is implied and should be avoided. See MPEP 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-9 recite the limitation "the radio communication" and "the functions" in the claims 8 and 9. There are insufficient antecedent basis for these limitations in the claim.

Referring to claims 10-11 are rejected as being dependent upon a rejected claim 9 above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

Art Unit: 2635

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Furuhashi et al. (US# 6,029,887).

Referring to claims 1 and 6, Furuhashi et al. disclose an electronic bankbook and processing system for financial transaction information using electronic bankbook as recited in claim 1. See Figures 1-2, 17 and respective portions of the apparatus and method.

Furuhashi et al. disclose a service system (i.e. an electronic checking system) (column 4 lines 39 to 46; see Figures 13, 17, and 28) comprising

issuing a sheet-shaped medium (10) (i.e. base board card) (column 11 lines 53 to 64; see Figure 1) which has, as means (i.e. a CPU on the IC chip 11) for certifying the right of obtaining a service from a facility (181) (i.e. a transaction information processing device) to execute service (column 11 line 65 to column 12 line 4; column 12 lines 50 to 56; see Figures 1 and 31),

an IC chip (11) attached thereto in which unique identification information is stored (column 15 line 25 to column 16 line 3; column 25 lines 52 to column 26 line 9; see Figures 10-12 and 25); and

storing information about right of use of the service in a server (177) (i.e. bank host computer) in relation to information of the issued IC chip (11) (column 19 line 52 to column 20 line 4; see Figure 17);

when receiving an inquiry (i.e. a request) based on the identification information of the IC chip (11) from a terminal (197,199 and 201) (i.e. an electronic bankbook read/write device with display) of the facility (181) to execute service (see Figure 18), generating a reply (i.e. a response) to the inquiry based on the identification information of the IC chip registered in the server (177) or information about right of use of service which is registered in the server in relation to the identification information; and sending the reply to a terminal (201) of the facility (181) to execute service (column 9 lines 24 to 38; column 20 lines 5 to 51; see Figures 17-18, 29 and 32).

Referring to claim 2, Furuhashi et al. disclose the service system according to claim 1, wherein the information about the right of use of a service includes at least one of user information (i.e. a bank code and an account number), information to check soundness, content of service, status of use and term of validity (column 15 line 25 to column 6 line 3; see Figures 10-12).

Referring to claim 3, Furuhashi et al. disclose a service system, to the extent as claimed with respect to claim 1 above, and the service system further including: information center (179) (i.e. a terminal controller) which is connected to the facility of service (181) (i.e. an transaction information processing device) via a communication line (i.e. a dedicated line) (column 19 line 53 to column 20 lines 17; see Figures 17-18).

Referring to claim 4, Furuhashi et al. disclose the service system according to claim 3, wherein the server (177) (i.e. a bank host computer) is configured so as to store the information to check soundness, to generate the reply to the inquiry based on the information, and to send the reply to the terminal of the facility (181) to execute service (column 20 lines 5 to 51).

Referring to claim 5, Furuhashi et al. disclose an information processing system, to the extent as claimed with respect to claim 1 above, and an information processing system including:
a memory unit for information of the IC chip in which information accompanied with identification information of the IC chip obtained by using the identification as a key is stored in a tabular form (i.e. in a table) (column 15 lines 25 to 65; see Figures 10 and 12).

Referring to claim 7, Furuhashi et al. disclose a service system, the claim 7 differ from claim 3 in that the claim requires the limitations of claim 5 already addressed above and Furuhashi et al. disclose all limitations to the extent as claimed with respect to claim 5 above and therefore claim 7 is also rejected for the same reasons given with respect to claim 5.

Claims 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Guthrie (US# 5,565,858).

Referring to claim 8, Guthrie discloses an electronic inventory system for stacked containers as recited in claim 8. See Figures 3, 6 and 8 and respective portions of the apparatus.

Art Unit: 2635

Guthrie discloses an interrogator (40 or 102) (i.e. an interrogator unit) (column 2 lines 22 to 32; column 12 line 65 to column 13 line 5; see Figures 3, 6 and 8) comprises:

A communication processing unit (262) (i.e. a GPS receiver) which executes the radio communication (i.e. GPS signal) (column 13 lines 6 to 25; see Figure 8);

An IC chip reading unit (268) (i.e. a code transceiver) which reads information in an IC chip (27) (i.e. an electronic tag) which is used for certification in a contactless manner (column 13 lines 26 to 44; see Figures 3 and 6);

A display unit (266) which displays the content read by the IC chip reading unit (268) (column 13 lines 26 to 44; see Figure 8); and

Switch (264) (i.e. switching in the controller that selected by the user interface) which selects the functions of the communication processing unit (262) and the IC chip reading unit (268) (column 13 lines 26 to 44; see Figure 8).

Referring to claim 9, Guthrie discloses an interrogator, to the extent as claimed with respect to claim 8 above, and the interrogator (102) further having a function to sent the data stored in the memory unit for information of IC chip (268) during the communication processing in the communication processing unit being executed (column 13 lines 26 to 50; see Figure 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2635

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guthrie (US# 5,565,858) as applied to claim 9 above, and in view of Garber et al. (US# 6,232,870).

Referring to claims 10-11, Guthrie discloses the interrogator according to claim 9, however, Guthrie did not explicitly disclose further comprise a soundness-determination processing unit which makes a comparison between the information in the IC chip and the print information read by the scanner to determine the soundness of the certificate.

In the same field of endeavor of applications for RFID systems, Garber et al. teach that a soundness-determination processing unit (108) (i.e. a computer) which makes a comparison between the information in the IC chip (110) (i.e. an electronic tag) and the print information read by the scanner (106) (i.e. detector) to determine the soundness of the certificate (column 13 lines 53 to column 14 line 18; column 16 lines 32 to 54; see Figures 4 and 13) in order to create a signals indicating the presence and locating of the electronic items.

One of ordinary skilled in the art recognizes the need to use a scanner to read the information in the RFID tag to compare with specific information stored in a reserved memory of Garber et al. in a handheld interrogator unit with a display to monitor the location of electronic tag of Guthrie because Guthrie suggests it is desired to provide that a handheld interrogator unit communicate with an electronic tags and GPS transmitter to determine the position of an electronic tags and a controller of a handheld interrogator unit regulates control signal (column 11 lines 43 to 56; column 13 lines 18 to 25) and Garber et al. teach that using an integrated

Art Unit: 2635

optical scanner to obtain information from a RFID tag to identify the data information on the display (column 11 line 49 to column 12 line 17; see Figure 13) in order to notify the feedback data information of an RFID tag to an operator easily. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to use a scanner to read the information in the RFID tag to compare with specific information stored in a reserved memory of Garber et al. in a handheld interrogator unit with a display to monitor the location of electronic tag of Guthrie with the motivation for doing so would have been to scan information of an electronic tag to process in a hand-held interrogator unit in order for the operator obtains feedback easily.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Raj (US# 5,008,661) discloses an electronic remote chemical identification system.

Iijima (US# 5,288,978) discloses a mutual authentication system and method which checks the authenticity of a device before transmitting authentication data to the device.

Bickley et al. (US# 5,430,441) disclose a transponding tag and method.

De La Huerga (US# 6,255,951) discloses an electronic identification bracelet.

Chen (US# 6,549,912) discloses a loyalty file structure for smart card.

Art Unit: 2635

Guthery (US# 6,567,915) discloses an integrated circuit card with identity authentication table and authorization tables defining access rights based on Boolean expressions of authenticated identities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam V Nguyen whose telephone number is 703-305-3867. The examiner can normally be reached on Mon-Fri, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nam Nguyen
March 31, 2004



MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

